

REMARKS

The Office Action rejected claims 2-5, 7, 9, and 24-30. Claims 4-5, 7, 9, 28-29, and 30 have been amended. Claims 2-5, 7, 9, and 24-30 are pending.

The following remarks refer to claim numbers and line numbers within the claims as they appear in the enclosed listing of claims.

Claims 4 and 5 have been amended to recite appropriate antecedent basis to claim 29 as amended herein. Specifically, the phrase "biodegradable polymer or" has been deleted from lines 2 and 3 of each claim.

Claim 7 has been amended to correct a clerical error, which occurred during the previous amendment to claim 7. Specifically, the phrase "wherein the aliphatic-aromatic copolyester and" has been deleted from line 1.

Claim 9 has been amended for clarity and to recite appropriate antecedent basis to claim 29 as amended herein. Specifically, the phrase "biodegradable polymer or" has been deleted from line 1 and the word --further-- has been inserted before the word "comprises" in line 2.

Claim 27 has been amended to recite appropriate antecedent basis to claim 30 as amended herein. Specifically, the word --polymer-- has been inserted after the word "biodegradable" in line 2.

Claim 28 has been amended for clarity and to recite appropriate antecedent basis to claim 30 as amended herein. Specifically, the phrase --wherein the biodegradable polymer composition-- has been added in lines 1-2 and the word "comprising" in line 2 has been replaced by the word --comprises--. A colon has also been added in line 2.

Claim 29 has been amended for clarity and readability. Specifically, the phrase "biodegradable polymer or biodegradable polymer" has been deleted in line 4. Also, after the word "composition" in line 4, the following phrase has been added --comprising a biodegradable polymer having a degradation rate, wherein the phenol compound is added--. Further, the phrase "or biodegradable polymer composition" has been deleted from lines 7, 9, and 11. Also, in line 9, the phrase --thereby providing a biodegradable polymer composition-- had been added. Lastly, a typographical error in the word "cyclohexanedimethanol" has been corrected.

Claim 30 has been amended for clarity and readability. Specifically, the phrase “or biodegradable polymer-second material” in line 3 and the phrase “or biodegradable polymer-second material composition” in line 10 have been deleted. Also, claim 30 has been reorganized by switching the places of parts a. and b. Further, original part a., which is now part b. in the amended claim, has been reworded to improve the readability of the claim. Lastly, a typographical error in the word “cyclohexanedimethanol” has been corrected.

No new matter has been added by these amendments; therefore, Applicants respectfully request that examination continue on the claims as amended herewith.

Withdrawal of Prior Art Rejections

Applicants acknowledge that the previously presented prior art rejections has been withdrawn.

Rejections under 35 U.S.C. § 112

The Office Action rejected claims 2-5, 7, 9, and 24-30 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention.

Specifically, the Office Action asserted that because independent claim 29 recites the transitional phrase “consisting essentially of” after the biodegradable polymer or biodegradable polymer composition whereas dependent claim 9 recites the transitional phrase “comprises,” the claims are inconsistent. Claim 9 has been amended for clarity and now recites the phrase “further comprises.” Therefore, it is believed that this rejection has been obviated.

The Office Action also asserted that claim 7 is not clear with respect to the reference to the aliphatic-aromatic copolyester. Claim 7 has been amended to correct a clerical error by deleting the phrase “wherein the aliphatic-aromatic copolyester and.” Therefore, this rejection is believed to be obviated.

The Office Action further asserted that claim 30 is inconsistent in that the transitional phrase “comprises” is used in line 4 in regards to “the biodegradable polymer or biodegradable polymer second-material composition” whereas the transitional phrase “consisting essentially of” is used in lines 11. Claim 30 has been amended to improve the readability of the claim by deleting the phrase “or biodegradable polymer second-material” in line 3. Accordingly, in lines

3-4 of amended claim 30 the transitional phrase “comprising” relates to the biodegradable polymer composition for making an article. That is, the claimed biodegradable polymer composition “comprises” the elements recited in parts a. and b. The transitional phrase “consisting essentially of” used in line 11 relates to part a. (as amended herein), which has been amended to recite “a biodegradable polymer.” Thus, the two transitional phrases “comprising” and “consisting essentially of” refer to different elements (*i.e.*, the biodegradable polymer composition and the biodegradable polymer, respectively) and are not used in claim 30 inconsistently. Therefore, the rejection to claim 30 is believed to be obviated.

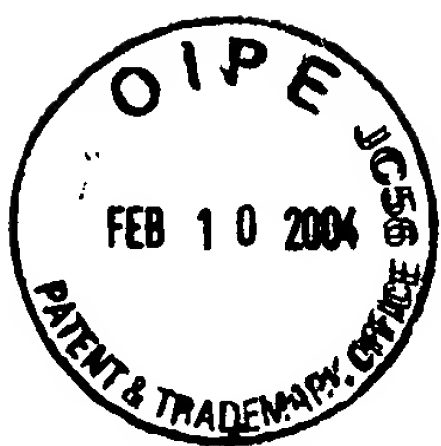
The Office Action also asserted that dependent claim 28 is inconsistent with claim 30 in that the transitional phrase “comprising” is used with respect to “the biodegradable polymer composition.” Claim 28 has been amended to recite appropriate antecedent basis to amended claim 30. Amended claim 28 now recites that the “biodegradable polymer composition further comprises” one or more of the recited list of compositions. Accordingly, in regard to the “biodegradable polymer composition,” claim 30 recites the transitional phrase “comprising” and dependent claim 28 recites the phrase “further comprising.” The transitional phrase “consisting essentially of” in claim 30 refers to the “biodegradable polymer” of part a. (as amended herein). Therefore, Applicants respectfully submit claims 28 and 30 are not inconsistent and that this rejection has been obviated.

Applicants note that the claims were deemed allowable over the prior art upon addition of the transitional phrase “consisting essentially of” in the prior response. The amendments herein are believed to be cosmetic and not for reasons related to patentability.

CONCLUSION


In light of the above amendments and remarks, the pending claims are believed to be in condition for allowance. Therefore, Applicants respectfully seek notification of same.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees that may be required, or to credit any overpayment, to Deposit Account No. 14-0629.



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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this Response to Office Action is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date shown below.


Jacqueline M. Hutter

2/6/04
Date